

**UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
WACO DIVISION**

Midas Green Technologies, LLC,

Plaintiff,

- vs. -

Rhodium Enterprises, Inc.;
Rhodium Technologies LLC;
Rhodium 10mw LLC;
Rhodium 2.0 LLC;
Rhodium 30mw LLC;
Rhodium Encore LLC;
Rhodium Renewables LLC;

Defendants.

Civil Action No. 6:22-cv-00050-ADA

Jury Trial Demanded

PLAINTIFF'S MOTION *IN LIMINE* NO.

TO EXCLUDE EVIDENCE OF ADVICE OF COUNSEL

I. INTRODUCTION

Rhodium has never asserted any advice-of-counsel defense, so they cannot use that as a reason for not attempting any design-arounds, or as a defense against their willful infringement. Rhodium has not presented any evidence it relied on counsel for its belief that it did not infringe the patents or that the patents are invalid.

II. STATEMENT OF LAW

Opinions of counsel may be helpful for an accused infringer to show it believed its actions were not infringing. *Varta Microbattery GmbH v. Audio Partnership LLC*, 2023 U.S. Dist. LEXIS 148400, *5-7 (E.D. Tex Aug. 22, 2023). Thus, before considering "the exculpatory value of an opinion of counsel, the legal advice contained therein must be found on the totality of the circumstances to be competent such that the client was reasonable in relying upon it." *Comark Communications, Inc. v. Harris Corp.*, 156 F.3d 1182, 1191 (Fed. Cir. 1998). "[W]hen an alleged infringer asserts its advice-of-counsel defense regarding willful infringement of a particular patent, it waives its immunity for any document or opinion that embodies or discusses a communication to or from it concerning whether that patent is valid, enforceable, and infringed by the accused [product]." *In Re EchoStar Communication Corporation*, 448 F.3d 1294,1304 (Fed. Cir. 2006).

III. ARGUMENT

A. Rhodium Has Not Produced Evidence Rhodium Acted on Advice as Counsel

Rhodium has not presented any evidence that it relied on advice of counsel when it continued to make allegedly infringing systems after this lawsuit was filed. Rhodium did not plead that it relied on advice of counsel in its answer to the Third Amended Complaint. Rhodium did not disclose it intended to rely on an advice of counsel defense in its Rule 26 disclosures.

Rhodium's witnesses never disclosed that they relied on advice of counsel when determining whether or not Rhodium infringed the '457 Patent. As a result, Rhodium has never asserted any advice of counsel for any purpose. As such, Midas respectfully requests that the Court limit any introduction of evidence or testimony at trial that Rhodium relied on advice of counsel.

IV. CONCLUSION

Midas respectfully requests that the Court preclude Rhodium and its experts from introducing evidence, testimony, or argument regarding any advice-of-counsel defense.

DATED: March 27, 2024

Respectfully Submitted,

/s/ Joseph E. Thomas

Joseph E. Thomas (*admitted p.h.v.*)

William J. Kolegraff (*admitted p.h.v.*)

Grant J. Thomas (*admitted p.h.v.*)

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LLC

CERTIFICATE OF CONFERENCE

The parties held a meet and confer on March 27, 2024 and Defendants plan to oppose this motion.

By /s/ Joseph E. Thomas
Joseph E. Thomas

CERTIFICATE OF SERVICE

I hereby certify that counsel of record who have appeared electronically in this case are being served with this document on March 27, 2024 by way of the primary email address that said counsel supplied to the Court's CM/ECF system.

/s/ Tierra Mendiola